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Subject: U.S. Trademark Application Serial No. 88359361 - FLIPPABLE FIRMNESS - 2.00020 - EXAMINER BRIEF

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U.S. Application Serial No. 88359361

Mark: FLIPPABLE FIRMNESS

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Reference/Docket No. 2.00020

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EXAMINING ATTORNEY'S APPEAL BRIEF

Applicant, Layla Sleep, Inc., has appealed the examining attorney's final refusal to register based upon Trademark Act Sections 1 and 45, 15 U.S.C. §§1051, 1127; 37 C.F.R. §§2.34(a)(1)(iv), 2.56(a), 2.63(b); TMEP §§904, 904.07, 1301.04(g)(i), because the specimen of use does not show use of the mark in connection with the services identified in the application.

ISSUE ON APPEAL

The issue presented on appeal is whether the specimen of record shows the applied-for mark in use in commerce in connection with the services identified in the application, namely, "online retail store services featuring bed frames, foundations, mattresses, pillows, toppers, and bed sheets".

STATEMENT OF RELEVANT FACTS

On March 30, 2019, applicant applied to register the mark FLIPPABLE FIRMNESS for "mattresses, pillows; mattress toppers" in International Class 20 and "online retail store services featuring bed frames, foundations, mattresses, pillows, toppers, and bed sheets" in International Class 35. On October 15, 2019, a Notice of Allowance was issued in relation to Classes 20 and 35. On July 20, 2020, applicant filed its Statement of Use in connection with Classes 20 and 35. On August 20, 2020, the examining attorney issued an Office action refusing the specimen of use as unacceptable for failure to provide a URL with the submitted specimen in Classes 20 and 35, and for failure to show use of the mark in connection with applicant's identified services in Class 35. On February 22, 2021, the applicant responded to the Office action by providing the required URL and by providing arguments with respect to the specimen refusal. On March 1, 2021, the examining attorney issued a final Office action with respect to the specimen for failure to show use of the mark in connection with the identified services in Class 35.

On April 27, 2021, applicant filed a request to divide Class 20 from Class 35. On April 29, 2021, the request to divide was granted and Class 20 was assigned a new serial number. On September 1, 2020, applicant filed a Request for Reconsideration providing additional arguments and a substitute specimen with respect to the specimen refusal. The Request for Reconsideration was denied on September 22, 2021. This appeal follows.

ARGUMENT

A. PRELIMINARY OBJECTION TO EVIDENCE ATTACHED IN APPLICANT'S BRIEF

Applicant has submitted new evidence with its appeal brief. Specifically, Applicant has submitted a Declaration in Support of Application, with an accompanying exhibit, Exhibit A. *See* Applicant's Brief at 20 – 23.

The record in an application should be complete prior to the filing of an appeal. 37 C.F.R. §2.142(d); TBMP §§1203.02(e), 1207.01; TMEP §710.01(c). Because applicant's new evidence was untimely submitted during an appeal, the trademark examining attorney objects to this evidence and requests that the Board disregard it. *See In re Inn at St. John's, LLC*, 126 USPQ2d 1742, 1744 (TTAB 2018), *aff'd per curiam*, 777 F. App'x 516, 2019 BL 343921 (Fed. Cir. 2019); *In re Fiat Grp. Mktg. & Corp. Commc'ns S.p.A*, 109 USPQ2d 1593, 1596 (TTAB 2014); TBMP §§1203.02(e), 1207.01; TMEP §710.01(c).

B. THERE IS NO DIRECT ASSOCIATION BETWEEN THE MARK AND THE IDENTIFIED SERVICES IN THE ORIGINAL SPECIMEN.

When determining whether a mark is used in connection with the services in the application, a key consideration is the perception of the user. *In re JobDiva, Inc.*, 843 F.3d 936, 942, 121 USPQ2d 1122, 1126 (Fed. Cir. 2016) (citing *Lens.com, Inc. v. 1-800 Contacts, Inc.*, 686 F.3d 1376, 1381-82, 103 USPQ2d 1672, 1676 (Fed Cir. 2012)). A specimen must show the mark used in a way that would create in the minds of potential consumers a sufficient nexus or direct association between the mark and the services being offered. *See* 37 C.F.R. §2.56(b)(2); *In re Universal Oil Prods. Co.*, 476 F.2d 653, 655, 177 USPQ2d 456, 457 (C.C.P.A. 1973); TMEP §1301.04(f)(ii). To show a direct association, specimens showing the mark used in rendering the identified services need not explicitly refer to those services, but "there must be something which creates in the mind of the purchaser an association between the mark and the service activity." *In re The Cardio Grp., LLC*, 2019 USPQ2d 227232, at *1 (TTAB 2019) (citing *In re WAY Media, LLC*, 118 USPQ2d 1697, 1698 (TTAB 2016)).

A mark for retail-store services is customarily located at the top web page, separated from the relevant goods by the website navigation tabs. TMEP §904.03(i)(B)(2). Example 3 in TMEP §904.03(i)(B)(2) illuminates this point by explaining that the MACYS.COM mark is located in the upper-left corner where retail service marks usually appear and retail store services indicia appear, such as "departments" or "express checkout sign-in".

In this case, the original specimen consists of a webpage displaying a product page for a mattress and the corresponding purchasing information. The webpage does not show a direct association between the mark and online retail store services, instead, it shows the applied-for mark used in connection with applicant's mattress product. Specifically, FLIPPABLE FIRMNESS is used as a signature feature of applicant's mattress.

The specimen depicts the product page for a mattress, and the sole place the mark, FLIPPABLE FIRMNESS, appears is under the product within the various paragraphs discussing the features and the product. *See* July 20, 2020, Statement of Use, TSDR at p. 3. This product page states "Our signature flippable firmness means you have two choices in one mattress to find the right fit for you. One side of the mattress has a soft, plush feel, or you can flip it over the other side for a firmer, even more supportive feel." Noting that a key consideration in determining whether a mark is being used in connection with the services is the perception of the user, consumers would view the use of FLIPPABLE FIRMNESS, as a feature of the mattress and not as a source identifier for online retail store services. Merely placing the mark on a website does not automatically mean the mark is used for the site as a whole. The requisite mark-services association is present when the specimen makes a direct link or connection between the mark and the identified services. *See In re Johnson Controls*, 33 USPQ2d at 1320. Therefore, registration must be refused if the specimen shows the mark is used only to promote goods rather than the identified services. *Id*.

Applicant argues that Exhibits A and C, consisting of articles, in Applicant's Request for Reconsideration shows how consumers perceive applicant's website and connect FLIPPABLE FIRMNESS with online retail store services. *See* Applicant's Brief at 13 – 14. The examining attorney respectfully disagrees with that contention.

For an advertisement or promotional material to show a direct association it must (1) explicitly reference the services and (2) show the mark used to identify the services and their source. *In re The Cardio Grp.*, LLC, 2019 USPQ2d 227232, at *2 (TTAB 2019) (quoting *In re WAY Media*, *LLC*, 118 USPQ2d 1697, 1698 (TTAB 2016)); TMEP §1301.04(f)(ii). In Exhibit A, an article posted by Applicant, Applicant solely uses the mark, FLIPPABLE FIRMNESS, to reference its mattress product, and does not use the applied-for mark to reference its online retail store services. *See* September 1, 2021, Request Reconsideration after FOA, TSDR at pp. 13 – 16. Additionally, Exhibit C, a U.S. News & World Report review article, states "Layla sells its products online through its website as well as on Amazon." *See* September 1, 2021, Request Reconsideration after FOA, TSDR at pp. 21 – 39 (this is contrary to applicant's statement that "Layla is exclusively an online retailer of mattresses and association products. *See* Applicant's Brief at 13).

Given that applicant's product is offered on Amazon's website, when consumers encounter applicant's mark in the product description on Amazon, consumers will not believe that applicant is the provider of the online retail store services, but believe that Amazon is the source of the online retail store services.

Finally, Applicant argues that the Examining Attorney failed to provide support to the proposition that "merely placing the mark on a website does not automatically mean the mark is used for the website." *See* Applicant's Brief at 15. Applicant's argument is unfounded as the examining attorney provided case law cites to support her analysis and conclusions. It has been established that a

specimen must show the mark used in a way that would create in the minds of potential consumers a sufficient nexus or direct association between the mark and the services being offered. *See* 37 C.F.R. §2.56(b)(2); *In re Universal Oil Prods. Co.*, 476 F.2d 653, 655, 177 USPQ2d 456, 457 (C.C.P.A. 1973); TMEP §1301.04(f)(ii). Here, applicant has failed to show the mark, FLIPPABLE FIRMNESS, used in a way that would create a sufficient nexus or direct association with online retail store services.

Therefore, Applicant's original specimen fails to show the mark, FLIPPABLE FIRMNESS, used in commerce with online retail store services.

C. THERE IS NO DIRECT ASSOCIATION BETWEEN THE MARK AND THE IDENTIFIED SERVICES IN THE SUBSTITUTE SPECIMEN.

An application based on Trademark Act Section 1(a) must include a specimen showing the applied-for mark as actually used in commerce for each international class of services identified in the statement of use. 15 U.S.C. §1051(a)(1); 37 C.F.R. §§2.34(a)(1)(iv), 2.56(a); TMEP §§904, 904.07(a); *see In re Gulf Coast Nutritionals, Inc.,* 106 USPQ2d 1243, 1247 (TTAB 2013). Generally, a specimen must demonstrate the mark serving as a source indicator for the identified services. TMEP §1301.04(d).

As discussed above, a service-mark specimen must show the mark sought to be registered used in a manner that demonstrates a direct association between the mark and services. Essentially, the mark must be shown "in a manner that would be perceived by potential purchasers as identifying the applicant's services and indicating their source." *In re DSM Pharm., Inc.*, 87 USPQ2d 1623, 1624 (TTAB 2008); *see In re JobDiva, Inc.*, 843 F.3d 936, 941, 121 USPQ2d 1122, 1126 (Fed. Cir. 2016) ("To determine whether a mark is used in connection with the services . . . a key consideration is the perception of the user."); *In reAncor Holdings, LLC*, 79 USPQ2d 1218, 1220 (TTAB 2006) (citing *In re Walker Research*, Inc., 228 USPQ 691, 692 (TTAB 1986)). A specimen must show the mark used in a way that would create in the minds of potential consumers a sufficient nexus or direct association between the mark and the

services being offered. *See* 37 C.F.R. §2.56(b)(2); *In re Universal Oil Prods. Co.*, 476 F.2d 653, 655, 177 USPQ2d 456, 457 (C.C.P.A. 1973); TMEP §1301.04(f)(ii). To show a direct association, specimens showing the mark used in rendering the identified services need not explicitly refer to those services, but "there must be something which creates in the mind of the purchaser an association between the mark and the service activity." *In re The Cardio Grp., LLC*, 2019 USPQ2d 227232, at *1 (TTAB 2019) (citing *In re WAY Media, LLC*, 118 USPQ2d 1697, 1698 (TTAB 2016)).

Applicant's substitute specimen does not show use of the proposed mark in connection with "online retail store services". Here, applicant's substitute specimens includes screenshots of results from a Google search of the words "FLIPPABLE FIRMNESS". *See* September 1, 2021, Request Reconsideration after FOA, TSDR at p. 41. A search results summary from an Internet search engine has limited probative value because such a list does not show the context in which the term or phrase is used on the listed web pages and may not include sufficient surrounding text to show the context within which the term or phrase is used. TBMP §1208.03; *see In re Bayer AG*, 488 F.3d 960, 967, 82 USPQ2d 1828, 1833 (Fed. Cir. 2007); *In re Star Belly Stitcher, Inc.*, 107 USPQ2d 2059, 2062 n.3 (TTAB 2013); TMEP §710.01(b).

Here, the Google search results provided and highlighted by the Applicant shows that the online retail store services are provided by "Layla". The highlighted results displays the wording "LAYLA" in black, where the entity providing the online retail store service is commonly displayed. Applicant notes in the substitute specimen that the display advertisement links consumers to "Layla's" online retail store where consumers can find mattress products. *See* Applicant's Brief at 10. The Google search results shows FLIPPABLE FIRMNESS used in connection with mattresses by stating "Layla Queen Size – Cooling Sleep- Copper Infused w/ Flippable Firmness." This use shows that the applicant uses the terms "FLIPPABLE FIRMNESS" to refer to a touted feature of a queen mattress product. *See* September 1, 2021, Request Reconsideration after FOA, TSDR at p. 41. A mark used in connections with products does not equate to the mark being used in connection online retail store services. For example, consumers

could search a name brand mattress and receive several results providing links to different retail stores where the name brand mattress can be purchased. In this case, consumers would not assume that the mattress brand is the source of the retail store services. This further shows that "Layla", and not FLIPPABLE FIRMNESS, is providing the online retail store services to consumers.

Additionally, Applicant included a screenshot from the Laylasleep.com webpage where the wording "Layla" is displayed prominently at the top of the webpage. *See* September 1, 2021, Request Reconsideration after FOA, TSDR at p. 43. The webpage screenshot does not show online retail store services because the webpage merely displays testimonials from past customers.

Applicant argues that the substitute specimens are advertisements that show a direct association between the mark, FLIPPABLE FIRMNESS, and the identified services, namely, online retail store services. *See* Applicant's Brief at 11. As noted above, to show a direct association, specimens consisting of advertising or promotional materials must (1) explicitly reference the services and (2) show the mark used to identify the services and their source. *In re The Cardio Grp., LLC*, 2019 USPQ2d 227232, at *2 (TTAB 2019) (quoting *In re WAY Media, LLC*, 118 USPQ2d 1697, 1698 (TTAB 2016)); TMEP §1301.04(f)(ii). When examining for the mark-services association, the examining attorney should consider the specimen's content, layout, and overall look and feel, as well as any description of the specimen and industry practice relating to service-mark usage in advertising and rendering the services. TMEP §1301.04(f)(ii). While the services need not be stated word for word, a specimen must show the mark used in a way that would create in the minds of potential consumers a sufficient nexus or direct association between the mark and the services being offered. See 37 C.F.R. §2.56(b)(2); *In re Universal Oil Prods. Co.*, 476 F.2d 653, 655, 177 USPQ2d 456, 457 (C.C.P.A. 1973); TMEP §1301.04(f)(ii).

Here, applicant's Google advertisements do not explicitly reference "online retail store services" and fails to show that the mark, FLIPPABLE FIRMNESS, is used in a manner that consumers would

understand that it is the source identifier of online retail store services. *See* September 1, 2021, Request Reconsideration after FOA, TSDR at p. 43. Applicant argues that potential customers, when viewing the Google advertisement, would understand that by clicking the advertisement the customer will be directed to a website offering retail store services. *See* Applicant's Brief at 11. However, consumer would not view every trademark associated with the products advertised to be the source identifier of every online retail store offering the advertised product.

The substitute specimens provides the entity name, description or name of the goods, price and a link to visit a website. In this case, the mark only appears in the name of good being shown in the advertisement. None of this information creates a nexus between the mark and online retail store services. Lastly, applicant cites several cases for the proposition that any doubt about whether purchasers perceive the mark is used in commerce should be resolved in favor of the applicant. *See* Applicant's Brief at 11 - 12. The cases cited by applicant discusses standards related to refusals that are not at issue in this matter. Accordingly, they are not relevant here.

As such, the substitute specimens fail to show the mark, FLIPPABLE FIRMNESS, used in commerce with online retail store services.

D. THIRD-PARTY REGISTRATIONS CONFIRM THAT CONSUMERS WILL NOT PERCEIVE A DIRECT ASSOCIATION BETWEEN THE MARK AND THE IDENTIFIED SERVICES.

In the March 1, 2021 Office action, the Examining Attorney provided third-party webpages as examples of how Applicant can show online retail store services. *See* March 1, 2021, Office action, TSDR at pp. 2 – 8. Applicant inaccurately states that the Examining Attorney cited registrations to support the Examining Attorney's arguments for refusing Applicant's specimen. *See* Applicant's Brief at 16.

Additionally, Applicant argues that the registrations attached in Applicant's Request for Reconsideration shows that the Applicant's specimens are acceptable to show online retail store

services. *See* Applicant's Brief at 16 – 19; *see also* September 1, 2021, Request Reconsideration after FOA, TSDR at pp. 44 – 70. Prior decisions and actions of other trademark examining attorneys in applications for other marks have little evidentiary value and are not binding upon the USPTO or the Trademark Trial and Appeal Board. TMEP §1207.01(d)(vi); *see In re USA Warriors Ice Hockey Program, Inc.*, 122 USPQ2d 1790, 1793 n.10 (TTAB 2017). Each case is decided on its own facts, and each mark stands on its own merits. *In re Cordua Rests., Inc.*, 823 F.3d 594, 600, 118 USPQ2d 1632, 1635 (Fed. Cir. 2016) (citing *In re Shinnecock Smoke Shop*, 571 F.3d 1171, 1174, 91 USPQ2d 1218, 1221 (Fed. Cir. 2009); *In re Nett Designs, Inc.*, 236 F.3d 1339, 1342, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001)).

In this case, the third-party registration attached to the Request for Reconsideration supports the examining attorney's refusal, because they show examples of how a service mark can be used in advertisements or electronic point-of-sale displays (in the form of websites) to show use in connection with retail store or online retail store services. The following are some examples where the nexus between the mark and the online retail store services exists because of the context in which the marks are used:

- The specimen for Registration No. 5197050, WE CHARGE WHAT WE NEED, NOT WHAT WE CAN, is a webpage where a reference to the shopping experience appears at the top, and the slogan (the registered mark) appears by itself. *See* September 1, 2021, Request Reconsideration after FOA, TSDR at p. 47. The webpage does not advertise any particular mattress model or product. Accordingly, consumers viewing the webpage would understand that "WE CHARGE WHAT WE NEED, NOT WHAT WE CAN" is used in the context of online retail store services.
- The specimen for the mark WAKE UP BETTER (Registration No. 5734184) features a webpage, and the mark is used to discuss the applicant's services, and not specifically in

connection with a particular product. *Id* at 51. Consumers viewing the webpage would understand that the mark WAKE UP BETTER is used as a source identifier for online retail store services because it is used in the context of offering a good customer experience, and the page mentions shipping, returns, and customer support – which is commonly features of online retail store services.

- The specimen for WORK HARD SLEEP HARD (Registration No. 6306835) features a webpage of the registrant. The webpage shows the mark being used as a slogan, and the webpage states below the slogan, "We sell more than mattresses; we want you to sleep better. Come try our mattresses today…." The message of selling mattresses and inviting consumers to come try the products communicates the idea that registrant is offering retail services.

Unlike the above-mentioned examples, applicant's specimens only show use of the mark in connection with a feature of its mattress product. None of the specimens submitted by the applicant creates a direct association between FLIPPABLE FIRMNESS and online retail store services in the mind of consumers.

Lastly, many of the cited registrations identify "retail store services" within the identification of services, which is broader wording than applicant's "online retail store services". As the cited registrations include broader wording, the specimen analysis of the cited registrations are different than that of applicant's specimen.

CONCLUSION

For the reason set forth above, the Examining Attorney respectfully submits that the specimens submitted do not show use in commerce with the identified services as contemplated by the Trademark Act. Accordingly, the refusal to register Applicant's mark pursuant to Sections 1 and 45 of the Trademark

Act, 15 U.S.C. §§1051, 1127; 37 C.F.R. §§2.34(a)(1)(iv), 2.56(a), 2.63(b); TMEP §§904, 904.07, 1301.04(g)(i).

Respectfully submitted,

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